

**REMARKS****1.) Claim Rejections – 35 U.S.C. §103**

Claims 1-3, 5, 7, 14-16, 18-20 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,389,008 issued to Lupien et al. (hereinafter "Lupien") in view of International Publication No. WO 99/11032 listing Peltola as an inventor (hereinafter "Peltola"). Before addressing this rejection in detail, it should be noted that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP 2142*. To establish *prima facie* case of obviousness, certain criteria must be met. First, the prior art reference or references when combined must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. With the above requirements in mind, Applicants respectfully traverse this rejection per discussion below.

In the Amendment dated February 10, 2004 Applicants indicated that independent claims 1 and 24 are amended by adding the limitation of "notifying the mobile station to synchronize with a remaining carrier" so as to overcome the cited prior art references. As previously discussed, Applicants again respectfully submit that Lupien, Peltola or their combination fails to teach or suggest this added claim limitation. Turning first to Lupien, it discusses a mobile station capable of accessing both circuit switched and packet data networks and having a default mode to access packet data or GPRS network. *Col. 15, lines 31-34*. Once the mobile station is registered with the GPRS network, the GPRS network automatically synchronizes the mobile station with the circuit switched network **without notifying the mobile station** of such synchronization. To do so, the SGSN 32 of the GPRS network informs the MSC/VLR 23 of the circuit switched network regarding the mobile station's registration with the GPRS network so that the HLR/AC 21 of the circuit switched network could be updated allowing the mobile station to later switch from packet data mode to circuit switched mode to receive an incoming circuit switched call. *Col. 15, lines 34-42 and Col. 16, lines 40-43*. In fact, Applicants' interpretation of Lupien is consistent with and is further

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supported by the Examiner's interpretation of Lupien. More specifically, the Examiner has cited column 15, lines 33-42 of Lupien and interpreted such section as indicating that [1] **circuit switched network is notified** regarding the mobile station's active state and [2] the **MSC/LVR 23 is notified** regarding the mobile station's registration with the GPRS network. *Office Action, page 7, first paragraph.* In contrast, the present invention **notifies the mobile station to synchronize with a remaining carrier and thereafter the mobile station is synchronized to such remaining carrier.** *See, e.g., Application, page 5, lines 7-15.* Thus, Lupien simply fails to teach or suggest this notification. Likewise, the same is true with Peltola. More specifically, the Examiner relies on Peltola for the disclosure of "synchronizing the mobile station to the default carrier." *See Office Action, page 3.* Even assuming *arguendo* that the Examiner's reliance is proper, such disclosure by Peltola has nothing to do with any notification. Thus, Peltola fails to teach or disclose all the limitations of claim 1.

Accordingly, claim 1 is believed to be non-obvious and patentably distinguishable over Lupien in view of Peltola.

Regarding claims 2-3, 5 and 7, they depend from claim 1, which is believed to be patentable, and thus such claims should also be non-obvious and patentably distinguishable over Lupien in view of Peltola. *MPEP 2143.03.*

Regarding independent claim 14, it contains limitations that are similar to those of claim 1 and thus claim 14 is believed to be non-obvious and patentably distinguishable over Lupien in view of Peltola for reasons similar to those discussed above regarding claim 1.

Regarding claims 15-16, 18-20 and 24, they depend from claim 14, which is believed to be patentable, and thus such claims should also be non-obvious and patentably distinguishable over Lupien in view of Peltola. *MPEP 2143.03.*

## 2.) Allowable Subject Matter

The Examiner's indication that claims 8-10, 12-13 and 21-23 are allowable is greatly appreciated.

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**CONCLUSION**

Claims 1-3, 5, 7-10, 12-16 and 18-24 are presently standing in this patent application. In view of the foregoing remarks, each and every point raised in the Office Action mailed on April 20, 2004 has been addressed on the basis of the above remarks. Applicants believe all of the claims currently pending in this patent application to be in a condition for allowance. Reconsideration and withdrawal of the rejections are respectfully requested. However, should the Examiner believe that direct contact with Applicants' attorney would advance the prosecution of the application, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

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